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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/668,392

09/23/2003

Edward M. Housel

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7590 02/14/2005

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EXAMINER

GLEITZ, RYAN M

ART UNIT

PAPER NUMBER

2852

DATE MAILED: 02/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/668,392

Applicant(s)

HOUSEL, EDWARD M.

Examiner

Ryan Gleitz

Art Unit

2852

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 15-20 is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. ____.  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____.   | 6) <input type="checkbox"/> Other: ____.                                    |

## **DETAILED ACTION**

### ***Information Disclosure Statement***

The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

### ***Claim Objections***

Claims 3 and 14 are objected to because of the following informalities:

"A toner-controlled preprinting procedure" (claim 3, line 1) lacks antecedent basis, and should read --A method of controlling a printer-- to parallel claims 1 and 2; and

"station" (claim 14, line 4) should be --stations--.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 4, 5, 12, and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Warbus et al. (US 6,236,816).

Warbus et al. disclose a method for controlling a printer including a blocked mode of operation that blocks printing operation for designated developer stations (col. 7, lines 5-11), which reads on a hold mode procedure, wherein the hold mode procedure may be enabled for any toner station or enabled only for at least one special toner station.

A toner station identification procedure, wherein if the hold mode procedure is enabled only for at least one special toner station, determines if a toner station installed in the printer is a special toner station (col. 6, lines 9-13).

The blocked mode is displayed on the operating panel, and printing with magnetic toner can only take place if the user is authorized (col. 7, lines 7-10) and enters the data word (col. 6, lines 65-67), which reads on and wherein the hold mode procedure comprises, automatically determining zero or more job ticket attributes for a job ticket, placing the printer into a hold status until the job ticket is approved, wherein when the job ticket is approved, allowing printing.

Regarding claim 4, the blocked mode of operation is a pre-print procedure.

Regarding claim 5, the special toner station is an MICR toner station (abstract, line 3).

Regarding claim 12, the data stored in the memory region characterizing the mode of operation (col. 7, lines 1-3) reads on sending notification including the job ticket.

Regarding claim 14, automatic identification of a developer station (col. 6, lines 9-13) inherently involves data encoding a table of zero or more toner stations and whether the toner station(s) is a special toner station. In order for the identity of the developer station to be used, it must be stored in some manner as data. Any manner of storing the data reads on a table. The pre-

printing procedure above is inherently implemented using a computer code. The printer is driven by a computer and the printer itself is a computer. Regardless of whether the instruction is controlled by hardware or software, it reads on a computer code.

Claims 1-4 and 6-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Motoyama et al. (US 5,760,928).

Motoyama et al. disclose a method for controlling a printer including the detection of a color of an original and a procedure for insuring the correct color of toner cartridge is present.

Figure 5 illustrates a hold mode procedure. When a special toner, for example a specific color, is needed the job is paused and the user is prompted (col. 7, lines 11-38), which reads on the hold mode procedure may be enabled for any toner station or enabled only for at least one special toner station.

A toner color detection unit (4) determines if a toner station installed in the printer is a special toner station. Referring again to figure 5, the hold mode procedure comprises, automatically determining zero or more job ticket attributes for a job ticket, for example color, placing the printer into a hold status until the job ticket is approved, wherein when the job ticket is approved, allowing printing.

Regarding claims 2 and 3, the approval of the job ticket or instruction to proceed with printing can either be made manually by the user as shown by the flow chart in figure 5 or automatically, when the automatic discrimination function is enabled (col. 8, lines 1-4), as shown by figure 6.

Regarding claim 4, the hold mode procedure above also reads on a pre-print procedure.

Regarding claim 6 and 7, when the original is black and the toner installed is red, the user is asked, "original color is different from cartridge color. Do you want to proceed with copying by ink-jet method?" (col. 7, lines 30-33). This reads on applying job overrides and job suggestions. The automatic discrimination procedure of figure 6 reads on automatically applying one or more attributes.

Regarding claims 8-10, choosing between the procedures of figures 5 and 6, that is deciding whether the automatic discrimination function is enabled (col. 8, lines 1-4), reads on a determining whether manual changes are enabled. Allowing manual changes, as shown in figure 5, reads on allow manual application of changes to one of the attributes of the corresponding database job tickets.

#### ***Allowable Subject Matter***

Claims 15-20 are allowed.

#### ***Contact Information***

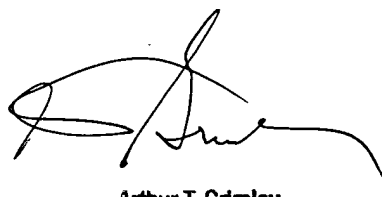
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ryan Gleitz whose telephone number is (571) 272-2134. The examiner can normally be reached on Monday-Friday between 9:00AM and 6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Arthur Grimley can be reached on (571) 272-2136. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2852

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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